

### **REMARKS**

Applicants have canceled claims 5, 10, and 11 without prejudice to introduction in a subsequent application or reintroduction in the present application. Applicants have added new claims 25-34. Support for new claims 25-34 is found in paragraphs [0039], [0074], [0103], and [0104] as well as elsewhere throughout the specification of the published application (US 2005/0121044). Additional support is found in Figures 1-3. Claims 19-22 are withdrawn in view of the Restriction Requirement mailed October 2, 2006. As result, claims 1-4, 6-9, 12-18, and 23-34 are pending in the application.

Claim 3 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent 5,789,337 to Haruta et al. (hereinafter "Haruta"). Claims 4-11 are rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent Application Publication 2003/0131859 to Li et al. (hereinafter "Li"). Claims 12-18, 23, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Haruta. Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Haruta as applied to claims 12-18 above and further in view of United States Patent 5,727,573 to Meier et al. (hereinafter "Meier").

Applicants respectfully request reconsideration of the present application in view of the following Remarks.

#### **Claim 3 and 35 U.S.C. § 112, Second Paragraph**

Claim 3 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the language of claim 3 is such that it cannot be definitively determined whether Applicants intend to claim particles comprising (1) any of the various metals or mixtures of the various metals or (2) a mixture of all the enumerated metals. Applicants have amended claim 3 to clarify that particles comprise (1) any of the various metals or mixtures of the various metals.

In view of the foregoing amendment, Applicants respectfully assert that claim 3 is compliant with the provisions of § 112, second paragraph, and respectfully request that the present rejection be withdrawn.

Claims 1-3 and 35 U.S.C. § 102(b)

The rejection of claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by Haruta is respectfully traversed.

Applicants have amended claim 1. Support for the present amendment to claim 1 can be found in paragraph [0039] as well as elsewhere throughout the specification of the published application (US 2005/0121044). Haruta does not describe or teach a catalyst composition wherein the substrate has an average diameter ranging from 0.05 to 2.0 mm. As a result, claim 1 is not anticipated by Haruta and Applicants respectfully request that the Examiner withdraw the present rejection. As claims 2 and 3 depend from and further limit claim 1, Applicants respectfully assert that claims 2 and 3 are not anticipated by Haruta and respectfully request that the Examiner withdraw the rejection of these claims as well.

Claims 4-11 and 35 U.S.C. § 102(e)

The rejection of claims 4-11 under 35 U.S.C. § 102(e) as being anticipated by Li is respectfully traversed.

Applicants have amended claim 4. Support for the present amendment to claim 4 is found in paragraphs [0100] through [0103] as well as elsewhere throughout the specification of the published application (US 2005/0121044). Additional support is found in Figure 1.

Li does not describe or teach a smoking article comprising a filter element comprising a catalyst composition chamber having a catalyst composition disposed therein. Li provides catalyst composition in the cut filler of the smoking article. As a result, Applicants respectfully assert that claim 4 is not anticipated by Li and respectfully request that the Examiner withdraw the present rejection. As claims 6-9 depend from and further limit claim 4 or an intervening dependent claim, Applicants respectfully assert that claims 6-9 are not anticipated by Li and respectfully request that the Examiner withdraw the rejection of these claims as well.

Claims 12-18, 23, and 24 and 35 U.S.C. § 103(a)

The rejection of claims 12-18, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Haruta is respectfully traversed. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 9891, 180 USPQ 580 (CCPA 1974).

A. Claims 12-18

As provided above, Li does not teach or suggest a smoking article comprising a filter element comprising a catalyst composition chamber having a catalyst composition disposed therein. Moreover, Haruta does not cure the deficiencies of Li as Haruta does not address a smoking article at all.

B. Claims 23 and 24

As provided above, Haruta does not teach or suggest a catalyst composition comprising ultrafine particles disposed on a substrate, the substrate having an average diameter ranging from 0.05 mm to 2.0 mm. Moreover, Li does not cure the deficiencies of Haruta as Li does not teach or suggest a catalyst composition comprising ultrafine particles disposed on a substrate, the substrate having an average diameter ranging from 0.05 mm to 2.0 mm.

In view of the foregoing, Applicants respectfully assert that claims 12-18 and 23-24 are patentable over Li in view of Haruta and respectfully request that the Examiner withdraw the present rejection.

Claim 7 and 35 U.S.C. § 103(a)

The rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Haruta as applied to claims 12-18 above and further in view of Meier is respectfully traversed.

For reasons consistent with those provided in the discussion of claims 4-11 and 12-18, the combination of Li and Haruta does not teach or suggest a smoking article comprising a filter element comprising a catalyst composition chamber having a catalyst composition disposed therein. Moreover, Meier does not cure the deficiencies of Li and Haruta. Meier also does not teach or suggest a smoking article comprising a filter element comprising a catalyst composition chamber having a catalyst composition disposed therein. As a result, Applicants respectfully assert that claim 7 is patentable over Li in view of Haruta and further in view of Meier and respectfully request that the Examiner withdraw the present rejection.

New Claims 26-34

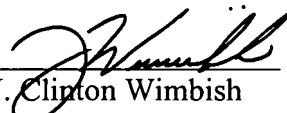
Applicants have added new claims 26-34. Support for new claims 26-34 is provided above. For reasons consistent with those provided herein, Applicants respectfully assert that new claims 26-34 are patentable over the applied prior art and the prior art of record in the application.

CONCLUSION

In view of the foregoing, a favorable Office Action is respectfully solicited. The Examiner is respectfully invited to contact J. Clinton Wimbish at 704.338.5021 to discuss any matter related to the present application.

Respectfully submitted,

7/18/07  
Date

  
J. Clinton Wimbish  
Reg. No. 54,545

Kilpatrick Stockton LLP